

REMARKS:

The claims in the application are 21-27, 29-31 and 34-39.

Favorable reconsideration of the application as amended is respectfully requested.

Claims 40-48 which have been withdrawn from consideration have been canceled without prejudice, the right specifically reserved to pursue a divisional application to the subject matter of these canceled claims. Claims 31 has been amended to eliminate the rejection under 35 U.S.C. §112, second paragraph, with independent Claims 21 and 31 respectively amended to incorporate recitation from Claims 28 and 33 which have been canceled without prejudice. Claims 29 and 34 have been amended to revise dependency.

Claims 21-39 have been rejected under 35 U.S.C. §102 as being anticipated by either JP1-256351 or U.S. Pat. No. 6,165,982 to Yamada et al. The amendment of Claim 31 to eliminate the formal rejection supra should also clearly distinguish over Yamada et al and eliminate this anticipatory rejection, in accordance with the bottom of page 5 of the Office Action. In any event, it is respectfully submitted all claims pending herein define over the applied art, for the following reasons.

Independent Claims 21 and 31 now recite, among other features, the sericin and/or hydrolyzed product ingredient is present in an average molecular weight range between 20,000 and 10,000. The average molecular weight of the sericin is not disclosed in JP1-256351, however, one of the joint inventors in the above-identified application has ascertained the sericin used in Examples 1 and 2

of that reference (there are no other Examples) possesses an average molecular weight of only 3,000, clearly outside the molecular weight range in the claimed invention. Accordingly, JP1-256351 clearly fails to anticipate the claimed invention.

Furthermore, while the sericin used in this reference might be "water-soluble" just after being derived from silkworm cocoons or raw silk, nevertheless it is essential to JP1-256351 that such sericin gel, even by merely being left to stand without any further treatment. More specifically, it has been explicitly ascertained by one of the joint inventors that JP1-256351 explicitly discloses:

An aqueous fibroin solution and aqueous sericin solution are both gelled even by leaving it as stands [emphasis added]

In contrast, the sericin and/or hydrolyzed product used in the present invention cannot be gelled as an aqueous solution in the absence of gelling agent, with the aqueous solution thus being maintained upon standing, unlike the sericin in JP1-256351. Thus the chemical or physical structure of the sericin used in the present invention is different from the sericin used in the applied reference. Accordingly, the claimed composition is clearly different from and not at all anticipated by JP1-256351.

Concerning Yamada et al, it is respectfully pointed out this reference fails to disclose an effective amount of sericin and/or hydrolyzed product to either prevent colon cancer (independent Claims 21 and 31) or any of the effective amounts enumerated, e.g., in the various dependent claims. In this regard, the comments regarding dependent Claim 39 being drafted in Markush format that have been raised in the Final Office Action concerning the art rejection are unclear; it is

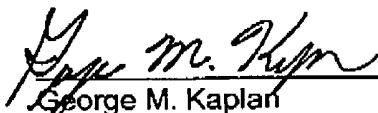
not understood how this Markush format impacts upon patentability because neither JP1-256351 nor Yamada et al disclose any of these effective amounts.

The term "effective amount" has long been accepted as both definite in a claim and capable of defining over the prior art: In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975); In re Halleck, 422 F.2d 911, 164 USPQ 647 (CCPA 1970); Ex parte Skuballa, 12 USPQ2d 1570 (Bd. Pat. App. & Inter. 1989); and Ex part Balzarini, 21 USPQ2d 1892 (Bd. Pat. App. & Inter. 1991). All "effective amounts" of the invention recited in the claims has been amply documented by the evidence contained in the present application.

Accordingly, in view of the forgoing amendment and accompanying remarks, it is respectfully submitted all claims pending in the present application are in condition for allowance. Please contact the undersigned attorney should there be any questions.

Early favorable action is earnestly solicited.

Respectfully submitted,



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